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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,370	01/30/2004	Lloyd E. Andrews	2065/US/2	7913

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EXAMINER

KAUFFMAN, PHILLIP

ART UNIT	PAPER NUMBER
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3652

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/769,370	Applicant(s) ANDREWS ET AL.	
	Examiner Phil J. Kauffman	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) 5-25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 30 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). You have two claims numbered "4". Misnumbered claim 4 is now renumbered 5, and so on through misnumbered claim 25, now renumbered 26. Appropriate changes were also made to the independent claim referenced in each dependent claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

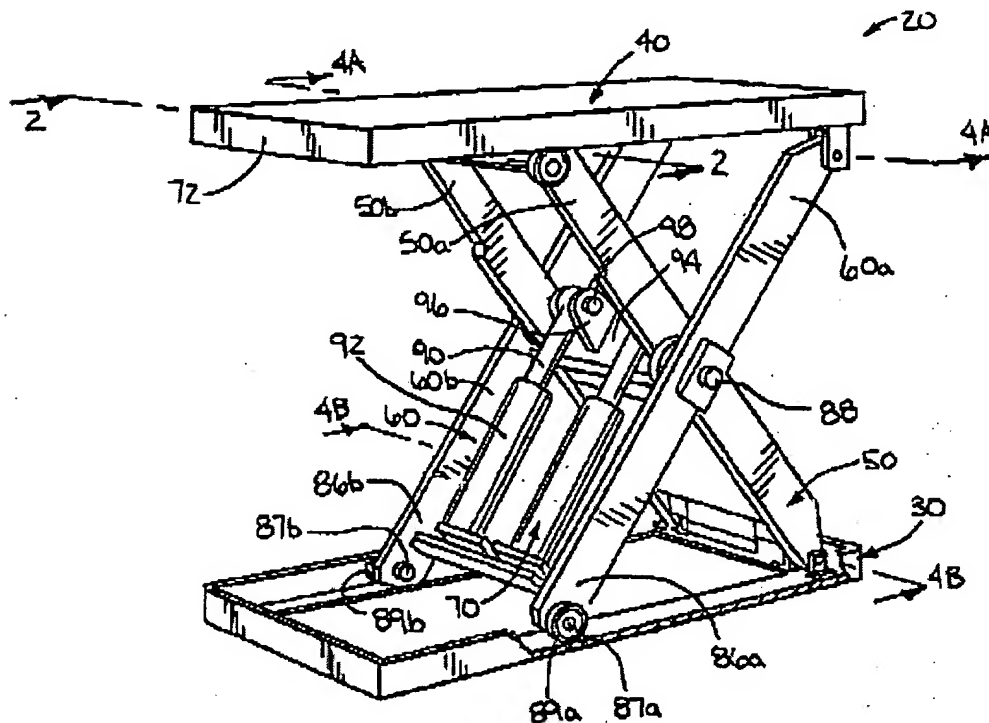
3. The disclosed invention is inoperative and therefore lacks utility, and the specification is not enabling as explained below.

4. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. Figure 30 shows scissor jacks 140 of trailer 124 in the extended position. Addressing the scissor jack in the front right of the figure, the lower end of the scissor jack cross member closest to the wheel 144 is fixed to the trailer, while the lower end of the other associated cross member is slideably engaged in track 172 of rail 170 atop bottom frame member 136. Both top ends of the cross members are fixed to top frame member 138, and there is no track 172 on the underside of top frame 138. The other sets of scissor jacks depicted are similarly secured. The scissor jack is immobile in this position and cannot move to the retracted position. In other words, the device is inoperable.
- b. In addition, please note, rail 172 can be seen atop bottom frame member 136 in figures 3, 4, 7, 10, 11, 13, 15, and 31. If a second rail 172 were mounted to the lower side of top frame member 138, it would be visible in these figures (the absence is most conspicuous in the last three figures listed).
- c. Paragraph 77 of the specification states "Since each scissor jack 140 has its own track 172 permitting free movement of the un-pinned ends, as shown in more detail in FIG. 25, each scissor jack can collapse to its retracted position without interfering with the other scissor jacks" [underlining added for emphasis]. In order to be operative, each scissor jack would require its own pair of tracks 172 (upper and lower) vice the track (singular) recited in the specification.

d. Below is an example of a scissor jack taken from US 6,974,123 B2 (Latvyns) show only to illustrate a functional version of a similar scissor jack. Please note the sliding connection on both the lower and upper surfaces.



e. No new matter should be entered.

5. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last line of claim 14 specifies a “support” connecting the mast support (186) to the mast dolly (128). It is unclear what the support is referring to. Is it kingpin 130? If so the lack of consistent terminology renders the claim indefinite. If it refers to something other than kingpin 130, what is it?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by McGovney et al. (4,569,168). Regarding claims 17 and 18, McGovney et al. discloses an oil derrick comprising at least a substructure and a rig floor. The device is used by moving the rig floor unitarily (portable rig 120) onto a trailer from a substructure (column 6, lines 45-50), moving the trailer carrying at least the rig floor, and moving the substructure separate from the trailer (substructure moveable separately, column 3, lines 41-43).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-5, 10, 11, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovney et al. (US 4,569,168) and Luth (US 4,684,314).

a. Regarding claims 1 and 5,

i. McGovney et al. discloses a self-elevating substructure for a portable oil derrick. The substructure (20) of the device comprises: a bottom frame (22), a top frame (26), and a structure (24) operable associated with the top and bottom frames for moving the frames towards and away from each other. The substructure is designed to be transported in its collapsed position on a single truck (column 2, lines 39-40). The advantages of McGovney et al's device include: being adjustable from a "collapsed oil rig loading position to an elevated oil rig supporting position" (column 1, lines 8-10), creating "a working space about the oil wellhead" (column 2, line 55), and providing a substructure of a low profile (column 3, lines 41-43).

ii. McGovney et al.'s device is not a trailer and does not have a moving means attached to the bottom frame to allow the trailer to be moved along the support surface.

iii. Luth discloses a pipe handling apparatus that comprises a trailer (3) with moving means (conventional wheel and axle assemblies 5) attached to the bottom frame so that the device is transportable (column 2, line 3).

- iv. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the collapsible, portable substructure of McGovney et al. with the trailer and moving means to Luth. The combined device would be transportable, with a low profile for transportation, and be capable of creating a working space about the wellhead.
- b. Regarding claim 2, McGovney et al.'s device can temporarily fix the position of the top and bottom frames by insertion of locking pins (64) through apertures (48 and 49)(column 5, lines 41-51).
- c. Regarding claims 3 and 10, Luth's device further comprises a hydraulic piston (109) for moving the top (19) and bottom (15) frames relative to one another (column 7, lines 38-45).
- d. Regarding claim 4, McGovney et al.'s structure includes a bifurcated intermediate support frame (24) with first and second traveling frames (24a and 24b) that are a scissor jack. Alternatively, the combined device could have used the more conventional scissor jack (21) of Luth.
- e. Regarding claim 11, McGovney et al.'s structure further comprises an alignment mechanism operative to align top frame with the surface of the oil rig (column 6, line 40 to column 7 line 8).
- f. Regarding claims 20 and 21, the combined device of McGovney et al. and Luth would operate by: disassembling the oil rig (120 of McGovney et al.) to form a top portion (McGovney et al. portable rig 120) and a bottom portion

(substructure lift 20), and transporting the top portion separately from the bottom portion (see McGovney et al. *Operation* at column 6, lines 40-50). The device would further operate by the top portion comprising a rig floor and mast (McGovney et al. portable rig 120), the bottom portion comprising a substructure (substructure lift 20), and transporting the rig floor on a trailer (column 6, lines 45-50).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luth and McGovney et al. as applied to claim 1 above, and further in view of Elliston (US 4290495). Elliston discloses a mobile drilling rig on a skid to facilitate transport on a barge (paragraph 42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the skid of Elliston with the combined device of McGovney et al. and Luth in order to facilitate transport of the device on a barge.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGovney et al. in view of Luth, as applied to claim 1 above, and further in view of Manten (US 4,368,602). Manten discloses a mobile drilling rig with a track that improves the transportation conditions (column 1, lines 64-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the track of Manten with the combined device of McGovney et al. and Luth in order to improve transportation conditions.

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12. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovney et al. in view of Luth as applied to claim 1 above, and further in view of Mobley (US 6,460,468 B1). Mobley discloses a device (a "improved truck-train system") including railroad wheels on a trailer and jeep (fifth wheel unit 24) to gain the advantage of transporting by rail (column 1, lines 14-15). The jeep unit is connected to the trailer when removed from the railroad track to facilitate movement by surface (column 7, lines 58-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the railroad wheels, and jeep of Mobley with the combined device of McGovney et al. and Luth in order to transport by rail and by surface.

13. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovney et al. in view of Luth, Hutchison et al. (4,591,006), and Busse (4,021,978).

a. Regarding claims 22-23, McGovney et al. discloses a self-elevating substructure for a portable oil derrick. The top portion comprises a rig floor and a mast (120, see figure 2 with rig floor visible resting on top frame 26). The bottom portion is substructure (20). The substructure is designed to be transported in its collapsed position on a single truck (column 2, lines 39-40). The top portion (120) may be transported on a trailer (column 6, lines 45-50). The advantages of McGovney et al's device include: being adjustable from a "collapsed oil rig loading position to an elevated oil rig supporting position" (column 1, lines 8-10),

creating "a working space about the oil wellhead" (column 2, line 55), and providing a substructure of a low profile (column 3, lines 41-43).

b. McGovney et al. does not disclose:

attaching the trailer to a vehicle by at least one jeep,
moving said substructure under its own power,
disconnecting the mast from the rig floor,
pivoting the mast on a kingpin by means of a draw works, and
loading the mast at least partially on a mast support and a mast dolly.

c. Hutchison et al. discloses a mobile drilling rig that has the advantage of being fully mobile (column 2, lines 50-54). The device serves as both the base and the mast of the oil rig.

d. Busse et al. discloses a mobile drilling rig that has the advantage of a mast that is itself a trailer (column 2, lines 9-10) facilitating "roading and rapid assembly and disassembly at the well site (column 1, lines 15-17). Busse et al. teaches: a mast (column 8, lines 3-32) that is itself a trailer attachable by at least one jeep (bogie 180), a mast detachable from the rig floor (50), a mast that pivots on a kingpin (trunnion engaging means 110, column 9, line 66 to column 10, line 16) as raised by a draw works, and at least partially loading the mast on a mast support (120) and mast dolly (108).

e. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the devices of Busse et al., Hutchison et al., and McGovney et al. The self propelled device of Hutchison et al. could be

incorporated into the substructure of McGovney et al. so that the substructure could move under its own power, gaining the advantage of being fully mobile.

The device would be further improved by incorporating the following properties of Busse et al.: making the mast itself a trailer attachable by at least one jeep, making the mast detachable from the rig floor, making the mast pivot on a kingpin as raised by a draw works, and at least partially loading the mast on a mast support and mast dolly. Incorporating these aspects of Busse et al.'s device would gain the further advantages of rapid assembly and disassembly.


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Claims 14 and 15 cannot be examined for indefiniteness; however, Busse et al. (US 4,021,978) may be relevant prior art for these claims. Busse et al. discloses a mast that functions as a trailer for itself, with a mast dolly (bogie 108) and a mast support (120).

15. Claims 12, 13, 16, 19, and 24-26 may be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phil J. Kauffman whose telephone number is (571)272-2305. The examiner can normally be reached on M-F 6:15-3:45 off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571)272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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